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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,799	02/24/2004	Yves Vanderveken	249190US0DIV	9759

22850 7590 10/04/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

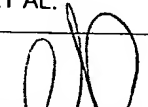
EGWIM, KELECHI CHIDI

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/784,799	Applicant(s) VANDERVEKEN ET AL.	
	Examiner Dr. Kelechi C. Egwim	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-25 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/581,806.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1 & 060704</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 18-23, drawn to an aqueous halogenated vinyl polymer dispersion comprising alkali metal phosphates, classified in class 524, subclass 414.
 - II. Claim 24, drawn to a method of coating paper using the dispersion of Group I, classified in class 162, subclass 135.
 - III. Claim 25, drawn to a method of producing pharmaceutical blister packs using the dispersion of Group I, classified in class 53, subclass 173.

The inventions are distinct, each from the other because of the following reasons:

2. Invention I is related to inventions II and III as product and processes of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using, as evidenced by groups II and III.

3. Inventions II and III are unrelated. The inventions are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Sam Ha on 9/29/04, a provisional election was made with traverse to prosecute the invention of Group I, claims 18-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24 and 25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 18, 20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Balwe et al. (USPN 3,817,959) or Sielfeld et al. (USPN 4,438,244).

Each of Balwe et al. (col. 3, lines 36-61 and col. 4, lines 20-22) and Sielfeld et al. (col. 2, lines 65-68 and col. 3, lines 40-48) individually teach aqueous dispersions of halogenated vinyl polymers, wherein the aqueous dispersion comprises alkali metal phosphates, such that the pH is between 3 and 8 in the case of Balwe et al. (see col. 3, lines 66-68) and between 2 and 10 in the case of Sielfeld et al. (see col. 3, lines 49-53), wherein the polymers may comprise vinylidene chloride monomers.

Thus the requirements for rejection under 35 U.S.C. 102(b) are met.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balwe et al. or Sielfeld et al.

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Although Balwe et al. or Sielfeld et al., above, may not disclose the particular species of alkali metal phosphates recited in this claim, the species of genus is prima facie obvious. It is applicants burden under these to establish that species or sub-species provides some unexpected results over the applied reference(s). See In re Woodroff, 16 USPQ2d 1934(Fed. Cir. 1990): In re Susi 169 USPQ 423 (CCPA 1971).

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balwe et al. or Sielfeld et al. in combination with McDonald (USPN 3,558,542) or DE 2603025.

Balwe et al. or Sielfeld et al., above, differ from the claimed invention in that they do not disclosed the inclusion of a wax in the chlorinated vinyl polymer dispersion. However, it is known in the art to have such aqueous preparations of chlorinated vinyl polymer contain a wax, particular in application such as films for food product or coating for cellulosic materials, for a variety of improvements, such as increasing heat-sealability to a product such as paper, such as taught by McDonald. (see abstract)

Each of McDonald and DE 2603025, individually teach aqueous dispersions of halogenated vinyl polymers with basic agents, containing waxes, for preparing coatings or films.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a wax in the aqueous dispersions of halogenated vinyl polymers in the of Balwe et al. or Sielfeld et al., in order to obtain the advantages taught by the prior art, motivated by a reasonable expectation of success.

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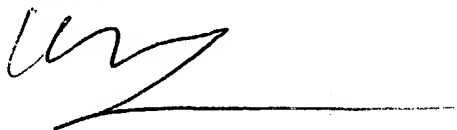
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, consisting of a stylized 'K' followed by a series of loops and a long horizontal stroke at the bottom.